IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 232

POPEIL BROTHERS, INC.,

Petitioner,

vs.

KARL ZYSSET AND NEW NEL KITCHEN PRODUCTS COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND MOTION TO VACATE PORTION OF COURT OF APPEALS' JUDGMENT AND REMAND TO THE DISTRICT COURT.

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PETITION FOR WRIT OF CERTIORARI AND MOTION TO VACATE PORTION OF COURT OF APPEALS' JUDGMENT AND REMAND TO THE DISTRICT COURT.

To The Honorable The Chief Justice and Associated Justices of The Supreme Court of The United States:

Popeil Brothers, Inc. prays that a writ of certiorari issue to review the final decision of the United States Court of Appeals for the Seventh Circuit in a case entitled "Karl Zysset and New-Nel Kitchen Products Company, Plaintiffs-Appellees *vs.* Popeil Brothers, Inc., Defendant-Appellant" because the Court of Appeals has departed from its appellate role to raise and to determine an issue not considered nor made the subject of findings below.

Petitioner also moves the Court, in the event the writ is issued, that it shall at that time, without oral argument, vacate so much of the judgment of the Court of Appeals

for the Seventh Circuit entered on April 14, 1960 as prematurely holds that Claim 2 of the patent in suit was valid and infringed, and remand such issue to the District Court for further proceedings and findings thereon.

OPINIONS OF COURTS BELOW.

A first opinion of the Court of Appeals is reported in 276 F. 2d 354; a second and modifying one from which this petition is prosecuted is reported in 276 F. 2d 358. They appear as Appendix I hereto. Two opinions of the District Court (affirmed in part and reversed in part by the Court of Appeals) are reported in 167 F. Supp. 362 and 122 U. S. P. Q. 128. They appear as Appendix II hereto.

DATES OF JUDGMENTS.

The first judgment of the Court of Appeals was entered on February 11, 1960. On timely Petition for Rehearing, the Court of Appeals on April 14, 1960 modified its first judgment to show that the judgment of the District Court was reversed in part and affirmed in part.

JURISDICTION.

Jurisdiction of this Court is invoked under 28 U. S. Code, Sections 1254 and 2101(c).

QUESTION PRESENTED.

The case presents a basic question of fair and appropriate federal procedure going far beyond the patent field, important though the question be to that particular field.

Is it not contrary to accepted and usual judicial procedure for a Court of Appeals, in a case having its origin in action by an expert administrative agency and which has been tried before a District Court, to act upon a legal and factual ground which did not exist previous to the

decision, and which was not considered by the agency or the District Court (nor argued by the litigants), without first remanding the case to the agency or to the District Court for appropriate evidence and findings thereon?

Or, stated otherwise,

Where there is a statutory mandate that every patent claim must particularly point out and distinctly claim the subject matter of the invention, is it proper and orderly judicial procedure for the Court of Appeals, for the first time and without prior Patent Office or District Court scrutiny, to find an incomplete patent claim valid standing alone?

THE STATUTE INVOLVED.

The Patent Statute is involved. Title 35, United States Code, Section 112, provides:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

STATEMENT OF THE CASE.

This is an action for infringement of Patent No. 2,782,826 entitled VEGETABLE SHREDDER issued to Karl Zysset, a Swiss national, in 1957. As issued, the patent included one complete or base claim (Claim 1), and one subsidiary or dependent claim (Claim 2) which was made complete only by incorporating by reference the base claim.

Petitioner defended on the ground, *inter-alia*, that the Zysset patent was invalid for lack of invention. The District Court held the entire patent valid and infringed. The Court of Appeals at first affirmed. Upon Petition for Rehearing, it reversed the District Court by holding the complete claim (Claim 1) invalid. However, it held the de-

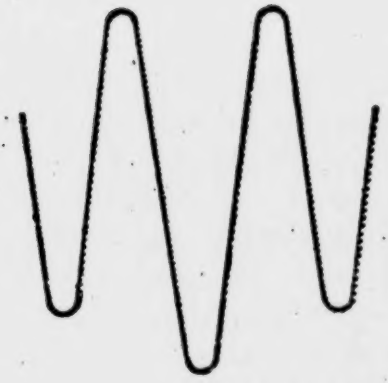
pendent claim (Claim 2) valid and infringed although there were no findings either by the Patent Office or by the District Court as to whether Claim 2 could stand alone if the base claim was invalid.

Although certiorari is sought primarily on procedural error by the Court of Appeals in deciding a case not presented below, some knowledge of the patent is helpful to an understanding of the procedural issue:

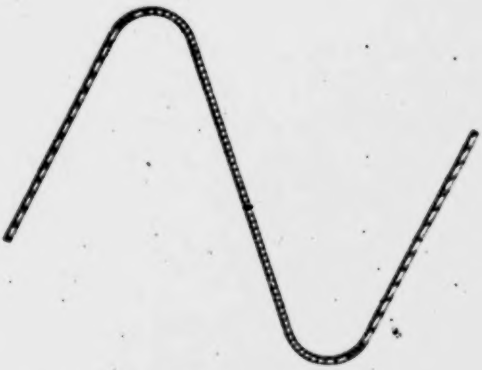
The device involved is a food chopper known to the trade as a kitchen "gadget." It consists of a bell shaped housing the lower end of which is open so that it may be placed over food on a chopping board. A handle which protrudes upward is tapped downward by the housewife, thus propelling a blade through the food. Zysset claimed in his base Claim 1 that the core of his alleged invention was a rotation device which caused the cutting blade to rotate on the upstroke so that on the next downstroke it sliced the food at a different place. The Court of Appeals held that so-called upstroke rotation was old and well known as shown by several prior patents, and therefore was not invention.

In subsidiary or dependent Claim 2, Zysset added to the rotating device of Claim 1 a "more or less sinuous" or "meandered" blade and a "wiper" or slotted cup through which the knife moves and which serves to remove food particles which might cling to it. As to this, the Court of Appeals for the first time and without prior scrutiny by the Patent Office, held that *a sinuous blade constituted invention*[1] and justified a monopoly; briefly, that Zysset's "sinuous" blade shaped (in cross section) thus:

1. "Here the sinuous blade constituted invention although found in a combination of other elements which were old in the art." Appendix I at p. 20, *infra*.



constituted invention over a "zigzag" blade used by a prior Swiss inventor Suter in 1932 and shaped (in cross-section) thus:



Or, stated another way, that a blade shaped more or less in the form of a "W" by Zysset constituted patentable invention over one shaped in the form of an "X" by Suter.

Although the Patent Office examined base Claim 1 of the patent and found it allowable over two prior art patents which it then considered, dependent Claim 2 was allowed *without independent examination* in accordance with the Patent Office practice of granting dependent

claims as a matter of course when the complete or base claim is found to be patentable.[2]

Further, no evidence was presented or considered by the trial court as to the validity of dependent Claim 2 of the patent standing alone.

The entire proceedings before the trial court centered about the base Claim 1. The trial court made no findings with respect to dependent Claim 2 *as an independent claim standing alone.*

The Court of Appeals found the base Claim 1 invalid as being in the public domain, but created a monopoly for the sinuous blade of the dependent Claim 2 by asserting that the additional twists Zysset added to his blade beyond those used by Suter constituted the "impalpable something which distinguishes invention from simple mechanical skill."[3]

REASONS FOR GRANTING THE WRIT.

The holding by the Court of Appeals that an incomplete patent claim, not found independently patentable by the Patent Office or the District Court, is valid standing alone is one of first impression. No prior decision can be found as precedent for this extraordinary step that does violence alike to proper judicial procedure and to established patent law.

The Court of Appeals has created a monopoly for a kitchen "gadget" solely upon the shape of a cutting blade which it has characterized as "sinuous" and therefore

2. *In re McCarn*, 212 F. 2d 797, 799, C. C. P. A., 1954. *Ex Parte Hofstadter*, 96 U. S. P. Q. 449, 450, Pat. Off. Bd. of App. 1952. *In re Harza*, 124 U. S. P. Q. 378, 381, C. C. P. A. 1960. *Ex parte Steil*, 31 U. S. P. Q. 343, Pat. Off. Bd. of App. 1936.

3. The Court of Appeals has adopted language from, but obviously has failed to follow the philosophy of, this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

patentable in an old combination over the myriad "zig-zag" blade shapes which have been common knowledge and in the public domain from time out of mind. (Contrast, *Great Atlantic & Pacific Tea Co.*, v. *The Supermarket Equipment Corp.*, 340 U. S. 147.) It has made this determination *sua sponte* without prior scrutiny and consideration of the issue either by the Patent Office or the District Court.[4]

The case presents a procedural question of deep importance in proper appellate procedure and of public interest in the patent field, because, if allowed to stand, it establishes a new method of obtaining a patent monopoly *ab initio* from the courts, for there is no doubt that the Court of Appeals has here created a patent monopoly which the Patent Office did not grant. There is nothing in the opinions of this Court indicating either that the courts have jurisdiction so to do, or that such a course is sound public or judicial policy.

If the case is permitted to stand, an important precedent

4. It is a matter of common knowledge that men have been making knives in sundry shapes for hundreds of years. Because of the lack of scrutiny by the Patent Office and the trial court of the blade shape upon which the monopoly of Claim 2 has been created by the Court of Appeals, the present record is incomplete as to the contribution to the public domain of sinuous blades *and* wipers. An example is the 1878 claim by inventors Wilson and McCally (United States patent No. 207,146):

will have been created under which the benefits of distillation of issues by an administrative body and application of its expertise, be the body the Patent Office, the National Labor Relations Board, the Federal Trade Commission, or other agency, will largely be lost:

Although the mechanics of review of agency action differ in detail, the principle that the courts should act only in an appellate capacity in cases arising from them is fundamental. The courts are not in position to, and should not make determinations, *sua sponte*.[5] And that principle has

5. The principle referred to in the text has repeatedly been affirmed by this Court in varying circumstances and as to varying agencies. Thus, in *Unemployment Compensation Com'n.* v. *Aragon*, 329 U. S. 143, 155, it was said: "A reviewing court usurps the agency's function when it sets aside the administrative determination upon a ground not theretofore presented and deprives the Commission of an opportunity to consider the matter, make its ruling, and state the reasons for its action." And, in *Hormel* v. *Helvering*, 312 U. S. 552, 556: "Recognition of this general principle has caused this Court to say on a number of occasions that the reviewing court should pass by, without decision, questions which were not urged before the Board of Tax Appeals." Other cases are: *Chicago, M., St. P. & P. R. Co.* v. *Illinois*, 355 U. S. 300, 309; *Schaffer Transp. Co.* v. *U. S.*, 355 U. S. 83, 92; *Federal Power Commission* v. *Colorado Interstate Gas Co.*, 348 U. S. 492; *Jacob Siegel Co.* v. *Federal Trade Commission*, 327 U. S. 608, 614; *Phelps Dodge Corporation* v. *N. L. R. B.*, 313 U. S. 177, 197; *N. L. R. B.* v. *Donnelly Garment Co.*, 330 U. S. 219, 237, remanding from Supreme Court to Court of Appeals just as Court of Appeals here should have remanded to District Court.

THIS FUNDAMENTAL JUDICIAL PRINCIPLE APPLIES TO PATENT CASES: In *O'Leary* v. *Liggett Drug Co.*, 6 Cir., 150 F. 2d 656, 667, it is said: "• • • in patent cases as well as in mill-run civil actions, a reviewing court would violate both the letter and the spirit of Civil Procedure Rule 52, should it pass upon a controverted issue of fact not determined in the trial court." In *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 1 Cir., 134 F. 2d 78, 89, it is said: "Neither do we propose to pass upon the validity of the claim ourselves. The record as transferred to us is not complete and even if it were our conclusion would not be different. The questions of fact necessarily raised by any consideration of the question of validity are exceedingly complicated and involved and the answer to be given to them depends in large part upon the credibility of expert and other witnesses. Under these circumstances it seems to us that the

added force in a patent case because such cases come to a Court of Appeals not directly from the agency but only after they have been through the District Court where supposedly the issues have been further refined, tested, and narrowed. The departure from this fundamental limitation on the function of a reviewing court has resulted in the egregious error noted in the appended footnote.[6]

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question of the validity of the claim as now construed is definitely one of fact and as such should be passed upon by the master and the court below in advance of consideration by us." Also, *Nelson Mfg. Co.* v. *Myers & Bros. Co.*, 6 Cir., 29 F. 2d 968; and *Kalle & Co.* v. *The Multazo Co., Inc.*, 6 Cir., 45 U. S. P. Q. 378, 380.

The principle applies to litigation not having its origin in agency action. *Irish* v. *U. S.*, 9 Cir., 225 F. 2d 3, 8, says: "In a case where the necessary findings are lacking on the appeal, the court does not dismiss the appeal, but vacates the judgment and remands the case to the district court for appropriate findings of fact." See other typical cases such as *Eden* v. *Lauriat*, D. C. Cir., 254 F. 2d 339; *Kreielsheimer* v. *Cohen*, 4 Cir., 252 F. 2d 330, 331; *McClure* v. *O. Henry Tent & Awning Co., Inc.*, 7 Cir., 184 F. 2d 636, 639. This Court summed the matter up as follows in *Kelley* v. *Everglades Drainage District*, 319 U. S. 415, 421: "It may be that adequate evidence as to these matters is in the present record. On that we do not pass, for it is not the function of this Court to search the record and analyze the evidence in order to supply findings which the trial court failed to make." The cause was remanded for such findings.

6. An example, and critical to the decision, of the difficulties created by the Court of Appeals' procedure is its asserted differentiation of the Zysset blade from that of Suter on the ground that Zysset's blade was one continuous piece of metal whereas Suter's consisted of three separate blades mounted in a continuous holder (p. 18-19, *infra*). *The District Court made no such finding* and the Suter patent plainly provided for *either* a number of separate blades set in a holder in "zigzag" fashion *or* a modification in which "knife-blades may be dispensed with if instead is used a chopping knife • • • which is also of zigzag-shape and is made of a solid piece of steel." (Appendix to Brief of Defendant-Appellant, p. 340.)

The Court of Appeals' error in attempting an initial analysis of what it understood the evidence to be led to its manifest oversight of the clearly stated "either—or" feature of Suter's patent. Had the Court of Appeals sent its asserted Claim 2 issue back to the District Court for a refinement of the findings, it is inconceivable that the latter Court would not have found that Suter provided for *either* a number of blades set in a zigzag holder *or* a continuous solid blade bent into whatever number of zigs and zags seemed appropriate to the size of the bell in which it operated.

So far as patent law is concerned, the decision undercuts all established procedures for testing and evaluating patents embodying dependent claims, for it permits segments of patent applications to become vested with monopoly although there has been no proper Patent Office or District Court investigation of the particular segment as an independent patent.

The Patent Statute provides (35 U. S. C. Sec. 112):

> "The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention." (Emphasis added.)

A dependent claim of a patent is one which is made whole only by incorporating therein another and complete base claim by reference. The statutory mandate cannot be met when such a dependent claim is emasculated by the invalidity of the base claim. The dependent claim is in the form:

> "2. A vegetable shredder *as set out in claim 1*, in which • • • etc." (Emphasis added.)[7]

When the Court of Appeals properly held base Claim 1 invalid, the dependent Claim 2 thereby became an incomplete fragment which, standing alone, cannot point out and claim any invention with the particularity and distinctness enjoined by the Patent Statutes.

So long as the Patent Office does not give dependent claims the required statutory scrutiny of patentability standing alone, all dependent patent claims must fall as a matter of law with their invalid base claims.

While we submit, therefore, that dependent Claim 2 should have been stricken down with the invalid base Claim 1, at worst for petitioner the case should have been remanded to the District Court for evidence and findings

7. Appendix to Brief of Defendant-Appellant, p. 546

directed to the Court of Appeals' theory that incomplete Claim 2 might be valid standing alone. This would be pursuant to "familiar appellate practice to remand causes for further proceedings without deciding the merits, where justice demands that course in order that some defect in the record may be supplied." (*Ford Motor Co.* v. *National Labor Relations Board*, 305 U. S. 364, 373. Note also *per curiam* remand in *Villa et al.* v. *Van Schaick, Superintendent*, 299 U. S. 152.)

The mischief which the Court of Appeals' doctrine will work is manifest. This particular decision shows an example of the mischief, for under it petitioner may be muleted of large damages on a miniscule fragment of a patent which it had been responsibly advised was basically invalid and which the Court of Appeals has found was basically invalid. The tail threatens to wag the dog and to inflict as great a wound as would the incisors. And the public is subjected to a patent monopoly that the Patent Office has not approved.

The Rules of Practice of the Patent Office authorize the writing of patent application claims in dependent form,[8] and a substantial percentage of patents are issued with such claims.[9] Repeated rulings of the Court of Customs and Patent Appeals have resulted in an established Patent Office practice by which a dependent claim is granted as a matter of course when the complete claim upon which it is based has been examined and granted.[10] Dependent claims, therefore, do not receive the critical scrutiny and application of the standard of invention dictated by statute and required by the prior rulings of this Court.

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8. Rule 75(e) reads: "When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim."

9. Patent Claims, Ridsdale Ellis, 1949, § 119, p. 144.

10. Footnote 2, *infra*.

It has been uniform practice of the courts to invalidate dependent claims when a base claim is invalidated. Such a practice is in harmony with the administrative procedure of the Patent Office under which dependent claims are not evaluated for patentability as separate claims standing alone.

Where, as here, the base claim is held invalid by an appellate court, it is procedurally improper to further hold the dependent claim valid standing alone. Once the dependent claim has been rendered fragmentary by invalidation of the base claim, it can no longer define an invention of the patent in compliance with the statutory mandate.

There is only one correct and orderly procedure in these circumstances and it was not followed by the Court of Appeals in this case. When it decided that the base Claim 1 was invalid, and if it believed it was possible that the dependent Claim 2 might be valid, it should have remanded the case to the District Court with instructions to take evidence as to the validity of the dependent claim when and if the patentee completed the dependent claim by rewriting it as a whole claim in accordance with the reissue provisions of the patent statute, 35 U. S. Code, Section 251. Only in that way could a proper record have been prepared as to the validity of the dependent claim as an independent one. Only in that way could the fragmentary dependent claim be completed and subjected to prior scrutiny by the Patent Office and by the trial court as an independently patentable claim.

CONCLUSION.

It is respectfully prayed that the writ of certiorari issue, and that upon this petition, the accompanying motion for an order of remand, and whatever response be made thereto) this Court enter its order vacating so much of the order of the Court of Appeals as finds Claim 2 of the patent to be valid and infringed and remanding the case to the Court of Appeals with directions for it to remand to the District Court, or, in the alternative, remanding directly to the District Court with directions for it to consider and determine the validity of Claim 2 in light of the fact that Claim 1 is invalid. Similar summary procedure has heretofore been used by this Court in correcting procedural errors. Cf. *N. L. R. B.* v. *Foote Bros. Gear & Machine Corp.*, 311 U. S. 620.

If the order of remand not be entered as we pray, petitioner respectfully reserves the right to file briefs and have oral argument should the writ of certiorari be issued.

Respectfully submitted,

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July 11, 1960.

CERTIFICATE OF SERVICE.

A copy of the foregoing Petition and Motion was mailed via first-class mail this 11th day of July, 1960 to Albin C. Ahlberg, 141 W. Jackson Blvd., Chicago, Illinois, Attorney for Karl Zysset, and to Warren C. Horton, 208 S. La Salle Street, Chicago, Illinois, Attorney for New-Nel Kitchen Products Company.

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